

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAYOSHI KURODA, YASUMASA MATSUDA,
HIROYUKI KUMAI, YASUHIKO KASAI,
KIYOSHI MASUDA, AKIHIRO KANEKO,
and JUNICHIRO TAKEYAMA

Appeal No. 1997-0411
Application No. 08/441,658¹

HEARD: November 2, 1999

Before THOMAS, FLEMING, and BARRY, Administrative Patent Judges.
BARRY, Administrative Patent Judge.

¹ The application was filed on May 15, 1995. It is a continuation of Application Serial No. 08/384,595, which was filed on February 3, 1995 and is now abandoned. The latter application was a continuation of Application Serial No. 08/117,680, which was filed on September 8, 1993 and is now abandoned. The latter application in turn was a continuation of Application Serial No. 07/757,612, which was filed on September 11, 1991 and is now U.S. Patent No. 5,302,969, granted on April 12, 1994.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the final rejection of claims 12, 14, 15, 18, 21, and 34. The appellants filed an amendment after final rejection on February 5, 1996, which was entered. We reverse.

BACKGROUND

The invention at issue in this appeal is a menu-driven computer for formatting a document. A user first chooses a type of document that he wants to produce. Responsive to the choice, the user is presented with a menu of formatting options relating to the paper size, paper direction, and printing direction of the type of document. He then selects one of the options or freely inputs his own formatting options. The document is formatted according to the selected or inputted options.

Claim 12, which is representative for our purposes, follows:

12. A method for setting paper size, paper direction and printing direction of a document in a document processing apparatus having both an editing

function and a display function, said setting method comprising the steps of:

- categorizing a plurality of basic menu items based upon either usage or purpose of said document;

- displaying said categorized plurality of basic menu items;

- designating one of said categorized plurality of basic menu items for said document;

- simultaneously displaying a plurality of document information selecting menu items which correspond to said designated one of said categorized basic menu items, each document information selecting menu item indicates a combination of paper size, paper direction and printing direction suitable to the usage or purpose of said document;

- designating one of said document information selecting menu items for said document;
- and

- performing an operation of setting paper size, paper direction and printing direction on said document according to said designated one of said document information selecting menu items.

The references relied on in rejecting the claims follow:

Weiner	4,862,390	Aug. 29,
1989		

M. Morris Mano (Mano), Computer System Architecture, pp. 264-266,
(2d ed., New Jersey, Prentice-Hall, Inc., Englewood Cliff, 1982).

BetterWorking Eight-in-One, (Cambridge, MA, Spinnaker Software Corp., 1989).

Broderbund software, Print Shop Reference Manual (Print Shop), 1984.

Claims 12, 14, 15, 18, 21, and 34 stand rejected under 35 U.S.C. § 103 as obvious over Print Shop in view of Eight-in-One, Mano, and Weiner. Rather than repeat the arguments of the appellants or examiner in toto, we refer the reader to the briefs and answer for the respective details thereof.

OPINION

In reaching our decision in this appeal, we considered the subject matter on appeal and the rejections and evidence advanced by the examiner. Furthermore, we duly considered the arguments of the appellants and examiner. After considering the totality of the record, we are persuaded that the examiner erred in rejecting claims 12, 14, 15, 18, 21, and 34. Accordingly, we reverse. The appellants make two arguments regarding the obviousness of claims 12, 14, 15, 18, 21, and 34. We address these seriatim.

First, the appellants argue, "since the 'data label direction' menu refers to the labeling of data in a graph ...,

the 'Eight-In-One' reference is contextually incompatible with the teachings of 'The Print Shop'," (Appeal Br. at 8.)

The examiner replies, "it would have been readily obvious that the 'Define Menu' of 'Eight-In-One' would add flexible [sic] to 'Print Shop' to enable not only the direction of paper to be changed but also fonts to be changed." (Examiner's Answer at 7.) We disagree with the appellants.

The appellants err in construing the criteria for obviousness. It is unnecessary that inventions of references be physically combinable to render obvious an invention. In re Sneed, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983). See also In re Nievelt, 482 F.2d 965, 968, 179 USPQ 224, 226 (CCPA 1972) ("Combining the teachings of references does not involve an ability to combine their specific structures."). The test for obviousness is not whether the features of a reference may be bodily incorporated into the structure of another reference but what the combined teachings of those references would have suggested to one of ordinary skill in the art. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Here, the examiner does not assert that the features of Eight-in-One may be bodily incorporated into the structure of Print Shop. Instead, he asserts that the combined teachings of the references would have suggested to one of ordinary skill in the art the appellants' invention. Next, we address the appellants' second argument, which attacks the persuasiveness of the examiner's assertion.

Second, the appellants argue, "as in 'The Print Shop', the 'Define Menu' [of Eight-in-One] provides ... no teaching or suggestion ... for enabling the user to designate ... the paper size, paper direction and printing direction" (Appeal Br. at 7 (emphasis omitted).) The examiner replies, "it would have been readily obvious that the 'Define Menu' of 'Eight-In-One' would add flexible [sic] to 'Print Shop' to enable not only the direction of paper to be changed but also fonts to be changed." (Examiner's Answer at 7.) We agree with the appellants.

Independent claim 12 specifies in pertinent part the following limitations:

12. A method for setting paper size, paper direction and printing direction of a document ... comprising the steps of:

...
simultaneously displaying a plurality of document information selecting menu items ..., each ... item indicates a combination of paper size, paper direction and printing direction ...;
designating one of said ... items for said document; and
performing an operation of setting paper size, paper direction and printing direction on said document according to said designated one of said ... items.

Similarly, independent claim 18 specifies in pertinent part the following limitations:

18. [A]n apparatus for setting a paper size, paper direction and printing direction of a document, comprising:

...
selecting means for selecting ... a menu of paper size, paper direction and printing direction setting items ...;
said selecting means further selecting a designated paper size, paper direction and printing direction setting item from said menu ... of paper size, paper direction and printing direction setting items; and
operating means for setting the paper size, paper direction and printing direction of said document in accordance with said selected document item and said selected paper size, paper direction and printing direction setting item.

Also similarly, independent claim 34 specifies in pertinent part the following limitations:

34. A method for setting paper size, paper direction, and printing direction of a document in a document processing apparatus ... comprising the steps of:

...
displaying a plurality of document information selecting menu items which correspond to said designated one of said categorized basic menu items, each ... item indicating a combination of paper size, paper direction and printing direction ...;

designating one of said ... items for said document; and

performing an operation of setting paper size, paper direction and printing direction on said document according to said designated one of said ... items.

Giving claims 12, 18, and 34, their broadest reasonable interpretation, the claims recite permitting a user to select the paper size, paper direction, and printing direction of a document and the setting of all of them.

The examiner fails to show a teaching or suggestion of these limitations in the prior art. Although he refers to the "'Banner mode of The Print Shop,'" (Examiner's Answer at 3), the examiner admits, "In the Banner mode format document information is fixed." (Id. at 6.) Because the reference does not even

teach selecting document formatting information, it neither teaches nor would have suggested permitting a user to select the paper size, paper direction, and printing direction of a document and the setting thereof.

Eight-in-One does not cure this deficiency. The reference teaches formatting a spreadsheet. P. 179. Specifically, Eight-in-One shows a "Graph Definition Screen." P. 234. We agree with the examiner that the Screen "explicitly shows a data direction selection area and an axis selection area." (Examiner's Answer at 4.) The Screen, however, does not show areas for selecting the paper size, paper direction, or printing direction of the spreadsheet. Consequently, the reference neither teaches nor would have suggested permitting a user to select the paper size, paper direction, and printing direction of a document and the setting thereof.

Neither Weiner nor Mano cures these deficiencies. The examiner notes, "Weiner is cited only as showing any menus can contain any number of names." (Id. at 4.) He adds, "Mano is used simply to show the type of structure on which the above mentioned combination of art could be used." (Id. at 7.)

For the foregoing reasons, the examiner has not established a prima facie case of obviousness. Therefore, we reverse the rejection of claims 12, 14, 15, 18, 21, and 34.

CONCLUSION

To summarize, the examiner's rejection of claims 12, 14, 15, 18, 21, and 34 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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)	
LANCE LEONARD BARRY)	
Administrative Patent Judge)	

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ANTONELLI, TERRY, STOUT
And KRAUS
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209

LLB/dal